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EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 07/19/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

SF

Office Action Summary

Application No.

09/612,324

Applicant(s)

EDWARDS ET AL.

Examiner

Carl Colin

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 4/19/2004, applicant amends claims 9, 11-13, and 18. The following claims 1-30 are presented for examination.

2. The amendments to the specification, page 2, filed on 4/19/2004 have been considered. The objection to the drawings has been withdrawn. The objection to claims 9 and 18 have been withdrawn.

2.1 Applicant's arguments, pages 8-10, filed on 4/19/2004, with respect to the rejection of claims 1-12 have been fully considered, but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 11, 20, and the intervening claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim limitations of claims 1, 11, 20 are not embodied in a computer hardware or software.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.1 **Claims 1-2, 4-5, 10-12, 14, and 19** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,754,707 to **Richards et al.**

4.2 **As per claim 1, Richards et al.** discloses a method of establishing communications comprising: establishing a virtual connection between a source endpoint located behind a first connectivity barrier and a destination endpoint located behind a second connectivity barrier, for example (see column 11, claim 1 and column 12, claim 14).

As per claim 11, Richards et al. discloses a method of establishing communications between source and destination endpoints comprising: establishing a session between the source endpoint located behind a first connectivity barrier and a service; and establishing a transport level communications connection between the service and the destination endpoint, the destination endpoint located behind a second connectivity barrier, for example (see column 11, claim 1 and column 12, claim 14).

As per claims 2 and 12, Richards et al. discloses the limitation of wherein at least one of the connectivity barriers comprises a firewall, for example (see column 11, claim 1 and column 12, claim 14).

As per claim 4, Richards et al. discloses the limitation of wherein establishing a virtual connection includes: establishing a first session between the source endpoint and a service; and establishing a second session between the destination endpoint and the service, for example (see column 11, claim 1 and column 12, claim 14).

As per claims 5 and 14, Richards et al. discloses the limitation of including assigning one or more servers associated with the service to handle the sessions, for example (see column 7, lines 27-48).

Art Unit: 2136

As per claims 10 and 19, Richards et al. discloses the limitation of including dynamically assigning at least one server associated with the service to handle the sessions, for example (see column 7, lines 27-48).

5. **Claims 20-21** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,185,606 to **Bereiter**.

5.1 **As per claim 20, Bereiter** discloses a system comprising: a service arranged to respond to a request from a first endpoint to establish communications with a second endpoint, wherein, if the second endpoint is located behind a connectivity barrier, a session initiated by the second endpoint is established with the service, and if the second endpoint is not located behind a connectivity barrier, a transport level communications connection is established with the second endpoint, for example (see column 3, line 40 through column 4, line 23).

As per claim 21, Bereiter discloses the limitation of wherein at least one of the connectivity barriers comprises a firewall, for example (see column 3, line 40 through column 4, line 23).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2136

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6.1 **Claims 3, 6-8, 13, and 15-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,754,707 to **Richards et al.** in view of US Patent 6,119,171 to **Alkhatib**.

6.2 **As per claims 3 and 13, Richards et al.** substantially teaches the claimed method of claims 1 and 11 of establishing communications comprising a firewall or proxy server or private Internet addresses. **Richards et al.** does not explicitly disclose one of the connectivity barriers comprises a consumer gateway. However, **Alkhatib** in an analogous art teaches using a consumer gateway to perform Network Address Translation thus allowing private network to communicate outside of the private network (e.g. via the Internet), for example (see column 2, lines 13-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Richards et al.** to provide at least one of the connectivity barriers as a consumer gateway to perform Network Address Translation thus allowing private network to communicate outside of the private network via the Internet as taught by **Alkhatib**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Alkhatib** so as to perform Network

Art Unit: 2136

Address Translation thus allowing private network to communicate outside of the private network (e.g. via the Internet).

As per claims 6-8 and 15-17, **Richards et al.** substantially teaches establishing communications using point-to-point addresses, and discloses an alternative when the connection cannot be made, for example (see column 5, lines 1-10), but does not explicitly disclose assigning a server to make a connection based on virtual host name associated with the first endpoint. However, **Alkhatib** in an analogous art teaches a process of establishing point-to-point connection where the service is arranged to assign a server to handle the session between the first endpoint and a service dynamically based on a virtual host name associated with the first endpoint. **Alkhatib** adds that such connection provides efficient and reliable service to users, for example (see column 8, lines 22-47 and column 7, lines 44-58). **Alkhatib** also discloses wherein the virtual host name comprises part of a hierarchical naming system, for example (see column 12, lines 1-21; column 8, lines 22-47 and column 5, lines 25-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Richards et al.** to provide an efficient and reliable service to users by assigning a server to handle the session between the first endpoint and a service based on a virtual host name associated with the first endpoint as taught by **Alkhatib**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Alkhatib** so as to provide an efficient and reliable connection service.

Art Unit: 2136

7. **Claims 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,754,707 to **Richards et al.** in view of US Patent 6,119,171 to **Alkhatib** as applied to claim 26 above and further in view of US Patent 6,571,290 to **Selgas et al.**

7.1 **As per claims 9 and 18**, both references substantially teach the claimed method of claims 6 and 15 of establishing communications between networks. Neither of the references explicitly teaches roaming between networks. It is well known in the art that roaming between networks is notoriously well known for a wireless to search between networks to reestablish sessions. **Selgas et al.** in an analogous art teaches a method of service that allows a user to roam between networks using attributes and provides at least ten advantages including offering access via multiplicity of network access providers, automatic configuration, and minimizing improper use of clients, etc., for example (see column 4, line 50 through column 5, line 45; see also abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method as combined above wherein the source endpoint can roam between networks to offer access via multiplicity of network access providers, as taught by **Selgas et al.** This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Selgas et al.** in order to offer access via multiplicity of network access providers, for example (see column 4, line 50 through column 5, line 45).

8. **Claims 22-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent US Patent 6,185,606 to **Bereiter** in view of US Patent 6,119,171 to **Alkhatib**.

8.1 **As per claim 22, Bereiter** substantially teaches establishing communications wherein at least one of the connectivity barriers comprising a firewall. **Bereiter** does not explicitly disclose one of the connectivity barriers comprises a consumer gateway. However, **Alkhatib** in an analogous art teaches using a consumer gateway to perform Network Address Translation thus allowing private network to communicate outside of the private network (e.g. via the Internet), for example (see column 2, lines 13-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Bereiter** to provide at least one of the connectivity barriers as a consumer gateway to perform Network Address Translation thus allowing private network to communicate outside of the private network via the Internet as taught by **Alkhatib**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Alkhatib** so as to perform Network Address Translation thus allowing private network to communicate outside of the private network (e.g. via the Internet).

As per claims 23-25, Bereiter substantially teaches establishing communications wherein the service is arranged to assign a server to handle the session between the first endpoint and the service dynamically, for example (see column 5, lines 15-25). **Bereiter** also discloses using point-to-point addresses, and further discloses an alternative when a point-to-point connection cannot be made, but does not explicitly disclose assigning a server to make a connection based on virtual host name associated with the first endpoint. However, **Alkhatib** in an analogous art teaches a process of establishing point-to-point connection where the service is

Art Unit: 2136

arranged to assign a server to handle the session between the first endpoint and a service based on a virtual host name associated with the first endpoint. **Alkhatib** adds that such connection provides efficient and reliable service to users, for example (see column 8, lines 22-47 and column 7, lines 44-58). **Alkhatib** also discloses wherein the virtual host name comprises part of a hierarchical naming system, for example (see column 12, lines 1-21; column 8, lines 22-47 and column 5, lines 25-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Bereiter** to provide an efficient and reliable service to users by assigning a server to handle the session between the first endpoint and a service based on a virtual host name associated with the first endpoint as taught by **Alkhatib**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Alkhatib** so as to provide an efficient and reliable connection service.

9. **Claims 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,754,707 to **Richards et al.** in view of US Patent 6,185,606 to **Bereiter**.

9.1 **As per claims 26-28, Richards et al.** substantially teaches an article comprising a computer-readable medium including computer-executable instructions for causing a computer system, in response to a request from a first endpoint located behind a first connectivity barrier to establish connectivity to a second endpoint, for example (see column 11, claim 1 and column 12, claim 14) and further teaches establish a session initiated by the second endpoint if the second endpoint is located behind a second connectivity barrier, for example (see column 5, lines 1-10).

Art Unit: 2136

Richards et al. further discloses establish a direct session with the second endpoint if the second endpoint is not located behind a connectivity barrier, for example (see column 5, lines 1-10 and column 4, lines 63-67). **Richards et al.** discloses assign a server to handle a session between the first endpoint and a service, for example (see column 7, lines 27-48). **Richards et al.** does not explicitly disclose making a determination in response to if endpoint is located or not behind a connectivity barrier. **Bereiter** in an analogous art teaches a system to establish a session initiated by the second endpoint if the second endpoint is located behind a second connectivity barrier and to instruct the first endpoint to establish a direct session or transport level communications connection with the second endpoint if the second endpoint is not located behind a connectivity barrier to adapt to the available communication path, for example (see column 3, line 40 through column 4, line 23). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Richards et al.** to establish a session initiated by the second endpoint if the second endpoint is located behind a second connectivity barrier and to instruct the first endpoint to establish a direct session with the second endpoint if the second endpoint is not located behind a connectivity barrier in order to adapt to the available communication path as taught by **Bereiter**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Bereiter** so as to provide the benefit to adapt to the available communication path.

10. **Claims 29-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,754,707 to **Richards et al.** in view of US Patent 6,185,606 to **Bereiter** as applied to claim 26 above and further in view of US Patent 6,119,171 to **Alkhatib**.

Art Unit: 2136

10.1 **Claims 29-30** contain the same limitations as claims 23-24 and claims 15-16 above.

Therefore, **claims 29-30** are rejected on the same rationale as the rejection of claims 23-24 and claims 15-16.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Cc

Carl Colin

Patent Examiner

July 1, 2004



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100